

REMARKS

Claims 31-54 are pending in the present application. By this Amendment, Applicants amend claims 31, 38, 45, and 52.

In the Office Action,¹ the Examiner rejected claims 31-51 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description; rejected claims 38-44 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter; and rejected claims 31-54 under 35 U.S.C. § 102(a) as being anticipated by Daniela Georke et al., "Employee Stock Plans Interface 1.0 Recommendation", HR-XML Consortium, October 7, 2002, pp. 0-65 ("Georke").

Applicants respectfully traverse all of the rejections presented in the Office Action and request allowance of the present application for the following reasons.

A. REJECTION OF CLAIMS 31-51 UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

The Examiner rejected claims 31-51 stating that "[t]he subject matter 'a validity period associated with *each of the plurality* of the content data' claimed in claims 31-51 are new subject matter because it is not disclosed in the specification." Office Action, p. 3, item 6 (emphasis in original). Applicants respectfully disagree. The specification of the application discloses, among other things, that the plurality of content data in record may include validity periods for each or at least one of the plurality of content data (see, for example, page 4, lines 15-26 and page 11, line 30 to

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

page 12, line 5). Therefore, the claims are supported by the present disclosure and no new subject matter has been introduced.

However, to advance prosecution of the present application, Applicants proposed in the Amendment After Final of November 2, 2006 to amend independent claims 31, 38, and 45 to delete “each” and insert “at least one.” The entry of these amendments places the language of claims 31, 38, and 45 to be similar to that presented in claim 52, which was not rejected by the Examiner. Applicants deem these amendments sufficient to overcome the rejection. Accordingly, Applicants respectfully request a withdrawal of the Section 112, first paragraph rejection.

B. REJECTION OF CLAIMS 38-44 UNDER 35 U.S.C. § 101

The Examiner rejected claims 38-44 stating that “[c]laims 38-44 claim a computer program product as computer program per se which is a non-statutory subject matter. A computer program needs to be embodied on a computer-readable medium to enable the underlying functionality to occur.” Office Action, p. 3, item 7. Applicants respectfully disagree as a “computer program product” is inherently something physical or tangible and capable of providing or enabling the underlying functionality.

None the less, to advance prosecution of the present application, Applicants proposed in the Amendment After Final mailed on November 2, 2006 to amend independent claim 38 to recite “A computer program product, tangibly embodied on a computer-readable medium.” Applicants deem this amendment sufficient to overcome the rejection as it is consistent with the Examiner’s suggestion in the Office Action.

Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the Section 101 rejection.

C. REJECTION OF CLAIMS 31-54 UNDER 35 U.S.C. § 102

Applicants respectfully traverse the Examiner's rejection of claims 31-54 under 35 U.S.C. § 102(a) as being anticipated by Georke. In order to properly establish that Georke anticipates Applicants' claimed invention under § 102, each and every element of each of the claims must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants submit that Georke does not disclose each and every element of Applicants' claimed invention.

Independent claim 31 recites a combination including, for example, "producing an internal document that includes the valid content data extracted from the updated record." The Examiner alleges that Georke teaches this feature of the claimed invention at page 19, paragraph 1. Specifically, the Examiner stated that the "maintenance file used to sent [*sic*] updated information is equivalent to Applicant's 'internal document.'" See Office Action, p. 5. Applicants respectfully disagree. In Georke, a company **sends** the maintenance file to, for example, a broker. "Plan information would be **sent** as a ... maintenance file to update plan information" (Georke, p. 19, emphasis added). However, the internal document disclosed in the present application is an "internal document," as claimed, and is not sent between two entities such as a company and a

broker. Further, as indicated below, the internal document of claim 31 is used to produce a file with valid content and it is that file which is then sent to, for example, a bank. Accordingly, the maintenance file of Georke does not anticipate or suggest the internal document of claim 31 and Georke does not disclose or teach any such internal document, as claimed in the present application.

Furthermore, the Examiner erroneously considers the maintenance file of Georke to be a valid teaching of both the internal document and the file recited in claim 31. See Office Action, p. 5. Without acquiescing to either characterizations of the Examiner regarding the internal document or the file, Applicants submit that the maintenance file in Georke cannot correspond to both the internal document and the file because they are distinct elements in claim 31.

In response to this argument, the Examiner stated in the Advisory Action of November 20, 2006 that “the claim language ... shows no relationship between an internal document and a file ... [and as] a result,.... an internal document that includes the valid content data and a file that includes the valid content can be both considered as maintenance file.” See Advisory Action, Continuation Sheet. Although Applicants disagree with the Examiner’s contention that the internal document and the file can be considered the same, in an effort to advance prosecution of this case, Applicants have amended independent claims 31, 38, 45, and 52 to recite “a file based on the internal document that includes the valid content” to show a relationship between the claimed internal document and the claimed file.

For the reasons stated above, Georke does not teach or suggest “producing an internal document that includes the valid content data extracted from the updated record,” as recited in claim 31. Moreover, claim 31 defines “producing a file based on the internal document that includes the valid content” and “sending the file at the periodic time interval.” As disclosed in the specification of the present application, the file is produced to include data corresponding to the content of the internal document (see, e.g., p. 2, lines 21-22). Therefore, claim 31 requires producing “an internal document” and producing and sending “a file” with valid content data. Accordingly, the claimed internal document and file are distinct elements that are neither disclosed nor suggested by the maintenance file of Georke and Georke is an inadequate reference for the rejection of the claims under Section 102.

Other features of claim 31 are also not disclosed or suggested by Georke. Independent claim 31 recites a combination including, for example, “extracting, at a predetermined time, valid content data from the updated record, the valid content data corresponding to content data having a validity period including the predetermined time.” The Examiner alleged that Georke teaches this feature of the claim at page 16, paragraphs 1, 4, 7, and 8 and at page 17, paragraphs 1 and 2. See Office Action, p. 5. Applicants respectfully disagree. The Examiner apparently considers the participant enrollment information, participant name, social security number, residential address, etc. of Georke to correspond to the claimed valid content data. Even assuming this characterization is correct, Georke is silent with respect to “the valid content data corresponding to content data having a validity period including the predetermined

time,” as recited in claim 31. Therefore, for this additional reference, Georke does not teach or suggest all of the features of claim 31 and the rejection under Section 102 should be withdrawn.

In view of the foregoing, Georke fails to disclose each and every element of independent claim 31. Georke thus cannot anticipate claim 31. Accordingly, Applicants respectfully request that the rejection of claim 31 under Section 102 be withdrawn.

Furthermore, independent claims 38, 45, and 52, although different in scope, include recitations similar to those discussed above in claim 31. Therefore, for at least reasons similar to those given above with respect to claim 31, claims 38, 45, and 52 are also not anticipated by Georke, and the rejection of claims 38, 45, and 52 should be withdrawn.

In addition, Applicants submit that dependent claims 32-37, 39-44, 46-51, and 53-54 are not anticipated by Georke at least by virtue of their dependence from allowable independent claims 31, 38, 45, or 52. Therefore, the rejection of claims 31-54 as anticipated by Georke should be withdrawn as well.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

A handwritten signature in black ink, appearing to be 'C. Gramenopoulos', written over a horizontal line.

Dated: December 21, 2006

By: _____
C. Gregory Gramenopoulos
Reg. No. 36,532